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LEXMARK INTERNATIONAL, INC. INTELLECTUAL PROPERTY LAW DEPARTMENT 740 WEST NEW CIRCLE ROAD BLDG. 082-1 LEXINGTON, KY 40550-0999			LAVIN, CHRISTOPHER L	
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			2624	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/736,872

Applicant(s)

CAMPBELL, MICHAEL CLARK

Examiner

Christopher L. Lavin

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 8-53 is/are rejected.
- 7) ☒ Claim(s) 2-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/16/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 8, 9, 11, 13, 16 – 24, 26, 28, 30, 48 and 50 – 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Kato (6,141,111).

In regards to claim 1, A method for selecting images from a plurality of images obtained from a digital device for printing with an imaging apparatus, said imaging apparatus having a scanner and accessing a memory storing said plurality of images, said method comprising the steps of: printing a thumbnail printout, said thumbnail printout including a plurality of thumbnails corresponding to said plurality of images (Figure 4, item 102; col. 5, lines 25 – 38); generating a selection sheet from said thumbnail printout by placing a first designation mark on said thumbnail printout for each thumbnail of said plurality of thumbnails corresponding to each image of said plurality of images on which a first action is to be taken (Figure 4; col. 5, lines 30 – 47); detecting said first designation mark by scanning said selection sheet with said scanner (col. 6, lines 27 – 38); printing a confirmation for confirming to a user that said each image on which said first action to be taken is designated (col. 5, line 62 – col. 6, line 5: printing the designated image is a means of confirming.); and performing said first action based on said detecting said first designation mark (col. 5, line 62 – col. 6, line 5).

In regards to claim 8, The method of claim 1, wherein the step of performing said first action includes printing (col. 5, line 62 – col. 6, line 5).

In regards to claim 9, The method of claim 1, wherein the step of performing said first action includes inhibiting printing (col. 5, line 62 – col. 6, line 5: The images that are not designed by the first mark for printing are not printed out, this is a way of inhibiting printing.).

In regards to claim 11, The method of claim 1, wherein: the step of generating said selection sheet further includes placing a second designation mark on said thumbnail printout for each thumbnail of said plurality of thumbnails corresponding to each image of said plurality of images on which a second action is to be taken, said second designation mark being different from said first designation mark, and said second action being different from said first action (Figure 4, Figure 6, Figure 8); the step of detecting includes detecting both said first designation mark and said second designation mark by scanning said selection sheet with said scanner (col. 6, lines 26 – 33); the step of performing includes performing both said first action and said second action based on said detecting both said first designation mark and said second designation mark respectively (col. 6, lines 34 – 53); and wherein the step of printing said confirmation includes printing a first confirmation mark and a second confirmation mark different from said first confirmation mark (col. 6, lines 34 – 53: Which ever actions are taken, be it e-mailing, image quality and size selection, or printer selection will result in the images being printed or e-mailed depending on the user selections these actions act as confirmations.).

In regards to claim 13, The method of claim 11, wherein said first designation mark has a first configuration, and said second designation mark has a second configuration different from said first configuration, wherein: said detecting both said first designation mark and said second designation mark includes detecting said first configuration and said second configuration respectively (col. 6, lines 26 – 33); and said performing both said first action and said second action is based on said detecting said first configuration and said second configuration respectively (col. 6, lines 26 – 53).

In regards to claim 16, The method of claim 1, wherein said scanner is an alignment sensor used for aligning a printhead of said imaging apparatus (Figure 1, item 3: The scanner must have some way of aligning in order for the image data to be read and acted upon.).

In regards to claim 17, claim 17 is rejected for the same reasons as claim 1. The argument analogous to that presented above for claim 1 is applicable to claim 17.

In regards to claim 18, The method of claim 17, wherein said first designation mark is an alpha-numeric symbol (Figure 4; Figure 8; col. 5, lines 39 – 47).

In regards to claim 19, The method of claim 17, wherein the step of performing said first action is based on a known location of said each thumbnail corresponding to said each image on which said first action is to be taken (col. 6, lines 26 – 33).

In regards to claim 20, The method of claim 17, said thumbnail printout further including a print option symbol, further comprising the step of: placing an option designation mark directly on said print option symbol on said selection sheet to designate a print option, wherein the detecting step includes detecting said option

designation mark (Figure 4: 103 is a print option symbol.); and wherein the step of performing said first action includes printing said each image on which said first action is to be taken using said print option based on a known location of said print option symbol (col. 6, lines 26 – 54).

In regards to claim 21, The method of claim 20, wherein said print option symbol is one of a plurality of print option symbols, said option designation mark is one of a plurality of option designation marks, and said print option is one of a plurality of print options (Figure 4 shows several print options symbols, the designation mark can be a check mark or a number in figure 4.).

In regards to claim 22, The method of claim 21, wherein each image of said plurality of images on which said first action is to be taken includes a first image on which said first action is to be taken and a second image on which said first action is to be taken, said step of said performing said first action including printing said first image using at least one print option of said plurality of print options and printing said second image using a different at least one print option of said plurality of print options (Figure 4).

In regards to claim 23, claim 23 is rejected for the same reasons as claim 8. The argument analogous to that presented above for claim 8 is applicable to claim 23.

In regards to claim 24, claim 24 is rejected for the same reasons as claim 9. The argument analogous to that presented above for claim 9 is applicable to claim 24.

In regards to claim 26, claim 26 is rejected for the same reasons as claim 11. The argument analogous to that presented above for claim 11 is applicable to claim 26.

In regards to claim 28, claim 28 is rejected for the same reasons as claim 13. The argument analogous to that presented above for claim 13 is applicable to claim 28.

In regards to claim 30, claim 30 is rejected for the same reasons as claim 16. The argument analogous to that presented above for claim 16 is applicable to claim 30.

In regards to claim 48, claim 48 is rejected for the same reasons as claim 11. The argument analogous to that presented above for claim 11 is applicable to claim 48.

In regards to claim 50, claim 50 is rejected for the same reasons as claim 13. The argument analogous to that presented above for claim 13 is applicable to claim 50.

In regards to claim 51, The method of claim 48, said thumbnail printout further including a print option symbol, further comprising the steps of: placing an option designation mark at said print option symbol on said selection sheet to designate a print option (col. 5, lines 25 – 47); and detecting said option designation mark by scanning said selection sheet with said scanner, wherein the step of performing said first action includes printing each said image on which said first action is to be taken using said print option (col. 6, lines 26 – 54).

In regards to claim 52, The method of claim 51, wherein: said print option symbol is one of a plurality of print option symbols (Figure 4); said print option is one of a plurality of print options (Figure 4); and said option designation mark is one of a plurality of option designation marks, wherein each image of said plurality of images on which said first action is to be taken includes a first image on which said first action is to be taken and a second image on which said first action is to be taken (col. 5, lines 25 – 47); and the step of performing said first action includes printing said first image using at

least one print option of said plurality of print options and printing said second image using a different at least one print option of said plurality of print options (col. 6, lines 26 – 54).

In regards to claim 53, claim 53 is rejected for the same reasons as claim 16. The argument analogous to that presented above for claim 16 is applicable to claim 53.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 10, 12, 14, 25, 27, 29, 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kato and Lumley (7,009,726).

In regards to claim 10, Kato discloses many different types of actions that can be taken based on user selection on the selection sheet; however, Kato does not disclose deletion as one of those options. Lumley teaches (Figure 1, item 41; col. 2, lines 4 – 9)

that a selection sheet for photos can be created that includes the option of deleting an image from the digital media.

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to include a delete option, as taught by Lumley, in the selection sheet disclosed by Kato. Allowing the user to delete images directly from the selection sheet will save the user time, as the selection sheet is possibly the first time the user has seen the image, it is the first time he or she would realize they don't want to keep the image. As the idea behind both of these patents is to allow the user to work with digital media without the need of a computer including other operations the user could perform on a computer makes Kato more fully featured.

In regards to claim 12, claim 12 is rejected for the same reasons as claim 10. The argument analogous to that presented above for claim 10 is applicable to claim 12.

In regards to claim 14, claim 14 is rejected for the same reasons as claim 10. The argument analogous to that presented above for claim 10 is applicable to claim 14.

In regards to claim 25, claim 25 is rejected for the same reasons as claim 10. The argument analogous to that presented above for claim 10 is applicable to claim 25.

In regards to claim 27, claim 27 is rejected for the same reasons as claim 10. The argument analogous to that presented above for claim 10 is applicable to claim 27.

In regards to claim 29, claim 29 is rejected for the same reasons as claim 10. The argument analogous to that presented above for claim 10 is applicable to claim 29.

In regards to claim 49, claim 49 is rejected for the same reasons as claim 10. The argument analogous to that presented above for claim 10 is applicable to claim 49.

6. Claims 31 – 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kato and Yoshihara (6,031,632).

In regards to claim 31, Kato as shown in the rejection of claim 1 discloses everything called for in this claim except for orientation marks. Using orientation marks with scanning is well known as shown by Yoshihara (Figure 7, items 1105 – 1108, col. 10, lines 28 – 33).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to use the orientation marks taught by Yoshihara on the selection sheet disclosed by Kato. Using orientation marks will ensure a more robust scan and lead to less error, and therefore fewer reprint operations.

In regards to claim 32, The method of claim 31, wherein said at least one orientation symbol includes at least one elongate bar (Figure 7).

In regards to claim 33, The method of claim 32, wherein said at least one elongate bar is printed in at least one corner of said thumbnail printout (Figure 7).

In regards to claim 34, The method of claim 33, wherein said at least one orientation symbol is configured to indicate at least four possible orientations of said thumbnail printout (Figure 7).

In regards to claim 35, The method of claim 34, wherein said at least one orientation symbol is at least four orientation symbols (Figure 7).

In regards to claim 36, The method of claim 35, wherein a first orientation symbol is an elongate bar, a second orientation symbol is two elongate bars, a third orientation symbol is three elongate bars, and a fourth orientation symbol is four elongate bars

(Yoshihara discloses 6 orientation marks in figure 7, it would have been obvious to one of ordinary skill in the art at the time of the invention to use any number of orientation marks. As long as the marks don't get so numerous they start to take away a significant portion of the selection page, more orientation marks will only increase accuracy, leading to fewer misreads and thus fewer times incorrect print jobs, or worse yet inappropriate deletions.).

In regards to claim 37, The method of claim 36, wherein said orientation is determined based on detecting a number of elongate bars (Figure 7).

In regards to claim 38, The method of claim 31, wherein the step of performing said first action is based on a known location of said at least one thumbnail based on the step of determining said orientation (This is the basic idea of using orientation marks.).

In regards to claim 39, claim 39 is rejected for the same reasons as claim 5. The argument analogous to that presented above for claim 5 is applicable to claim 39.

In regards to claim 40, claim 40 is rejected for the same reasons as claim 8. The argument analogous to that presented above for claim 8 is applicable to claim 40.

In regards to claim 41, claim 41 is rejected for the same reasons as claim 9. The argument analogous to that presented above for claim 9 is applicable to claim 41.

In regards to claim 43, claim 43 is rejected for the same reasons as claim 16. The argument analogous to that presented above for claim 16 is applicable to claim 43.

In regards to claim 44, claim 44 is rejected for the same reasons as claim 11. The argument analogous to that presented above for claim 11 is applicable to claim 44.

In regards to claim 46, claim 46 is rejected for the same reasons as claim 13. The argument analogous to that presented above for claim 13 is applicable to claim 46.

7. Claims 42, 45, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kato and Yoshihara as applied to claim 31 above, and further in view of Lumley.

In regards to claim 42, claim 42 is rejected for the same reasons as claim 10. The argument analogous to that presented above for claim 10 is applicable to claim 42.

In regards to claim 45, claim 45 is rejected for the same reasons as claim 42. The argument analogous to that presented above for claim 42 is applicable to claim 45.

In regards to claim 47, claim 47 is rejected for the same reasons as claim 42. The argument analogous to that presented above for claim 42 is applicable to claim 47.

Allowable Subject Matter

8. Claims 2 – 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: The art of record does not teach the concept of printing a confirmation directly onto a selection sheet. Bubie (6,453,078) teaches the concept of a digital index sheet which the user can select images on. These images are highlighted (showing confirmation). However, there is no reason to modify the base reference or Bubie to print out a confirmation on a selection sheet. There are many markup sheet reader references, for example Vilardebo (5,046,005) and George-Morgan (6,112,050), which

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teach the concept of printing a message of some kind onto a marked up sheet after scanning the sheet and interrupting the marks. But this is not the same as printing a confirmation that an action will be taken on the selection sheet.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. US Pat. 6,891,595 – Another Index print order form.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher L. Lavin whose telephone number is 571-272-7392. The examiner can normally be reached on M - F (8:30 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh M. Mehta can be reached on (571) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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